

Atty. Dkt. No. 200208954-1

## **6REMARKS**

This Reply is in response to the Non-Final Office Action mailed on March 16, 2006. In view of the following, reconsideration and allowance of the pending claims is requested.

I. **Claim Rejections – 35 USC § 103.**

**A. Claims 1, 2, 4-9, 11-13, and 15**

Claims 1, 2, 4-9, 11-13, and 15 stand rejected under 35 USC § 103(a) as being unpatentable over Ohba et al in view of Blackman et al (US 6,167,231).

Claim 1 is amended to recite “a controller electrically coupled to the sensor and configured to route the media sheet to the sheet-inverting duplexing path according to the detected characteristic.” Applicants submit that neither Ohba nor Blackman disclose this limitation. As such, this combination of references does not render claim 1 because these references fail to disclose all claim limitations. See MPEP 2143 (To establish *prima facie* obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations.)

In particular, Ohba does not teach routing to a duplexing path according to a detected characteristic. Indeed, as conceded by the Office Action, Ohba is silent regarding a duplexing path. Blackman also fails to disclose this limitation in that Blackman does not route media to a duplex path according to a detected characteristic of the media. Hence, because Ohba in view of Blackman fails to teach all the limitations of amended claim 1, claim 1 is non-obvious over this combination of references. Withdrawal of this rejection is requested.

Claims 2, and 4-6 depend upon claim 1 and are allowable for at least the same reasons claim 1 is allowable. Withdrawal of these rejections is requested.

Claim 7 is amended to recite “convey the media sheet to the media-inverting duplexing path in response to determining one or more print-impairing characteristics on the media sheet.” Applicants submit that this limitation is not disclosed in either

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Ohba in view of Blackman because neither of these references, either alone or combined, discloses conveyance of a media sheet to a duplexer in response to determining one or more print-impairing characteristics on the media sheet as recited in claim 7. Ohba is silent regarding duplexing. Blackman does not duplex in response to a determination of one or more print-impairing characteristics on the media sheet. Consequently, because Ohba in view of Blackman fails to teach all the limitations of amended claim 7, claim 7 is non-obvious over this combination of references. Withdrawal of this rejection is requested.

Claims 8 and 9 depend upon claim 7 and are allowable for at least the same reasons claim 1 is allowable. Withdrawal of these rejections is requested.

Independent claim 11 stands rejected as unpatentable over Ohba in view of Blackman. Applicants respectfully traverse this rejection on the basis that the combination of Ohba in view of Blackman does not show all claim limitations of claim 11. See MPEP 2143 (To establish *prima facie* obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations.).

In particular, Ohba in view of Blackman fails to disclose "routing the media sheet to a media-inverting duplexing path when the data from a first side of the media sheet fails to qualify the media sheet" as recited in claim 11. Indeed, as mentioned above, Ohba is silent regarding duplexing. Blackman does disclose routing the media sheet to a media-inverting duplexing path when data from a first side of a media sheet fails to qualify the media sheet. Thus, since Ohba in view of Blackman does not disclose all claim limitations of claim 11, the Office Action fails to establish *prima facie* obviousness of claim 11 and this rejection is improper. Withdrawal of the rejection of claim 11 is requested.

Claims 12-15 depend upon claim 11 and are allowable for at least the same reasons claim 11 is allowable. Withdrawal of these rejections is requested.

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### **B. Claims 3, 10, and 14**

Claims 3 depends upon claim 1 and is allowable for at least the same reasons claim 1 is allowable. Claim 10 depends upon claim 7 and is allowable for at least the same reasons claim 7 is allowable. Claim 14 depends upon claim 11 and is allowable for at least the same reasons claim 11 is allowable. Withdrawal of these rejections is requested.

### **C. Claims 16-20**

Claims 16-20 are allowed. Applicants agree with the Examiner's conclusions regarding patentability, without necessarily agreeing with or acquiescing in the Examiner's reasoning. In particular, Applicants believe that the application is allowable because the prior art fails to teach, anticipate, or render obvious the invention as claimed, independent of how the invention is paraphrased.

### **II. Conclusion.**

Applicants believe that the present application is in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 08-2025. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 08-2025. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 08-2025.

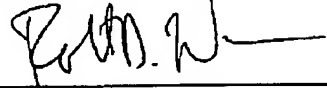
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Date 6/13/2006  
Hewlett-Packard Company  
P.O. Box 272400 M/S 35  
Fort Collins CO 80527-2400

Respectfully submitted,

By   
Robert D. Wasson  
Registration No. 40,218  
Telephone: 360-212-2338

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